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09/607,852	06/30/2000	Paul Lapstun	NPA026US	9767

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

BASOM, BLAINE T

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 07/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/607,852

Applicant(s)

LAPSTUN ET AL.

Examiner

Blaine Basom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Information Disclosure Statement*

The information disclosure statement filed 1/4/2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Specifically, U.S. Patent Nos. 5051736, 5477012, 5652412, 5661506, and 5852434 are cited in the information disclosure statement but no copies of these Patents are included. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,330,976, which is attributed to Dymetman et al. (and hereafter referred to as "Dymetman"). In general, Dymetman discloses a method for encoding information on paper, whereby this encoded information specifies "actions," such as the retrieval of supplementary documentation. This encoded information is invisible to the user, but may be deciphered via a specially-designed pointer (see column 3, lines 21-63; and column 4, line 63 - column 5, line 4). Regarding the claimed invention, Dymetman discloses that this encoded paper may be implemented along with a fax machine to provide email capabilities to a user, eliminating the need for a computer (see column 22, lines 10-23). It is therefore understood that Dymetman teaches a method of enabling remote conferencing between conference participants, wherein particularly, such remote conferencing is enabled via this encoded paper.

With respect to claim 1, Dymetman discloses that a user emails a message by first writing the message on "NotePaper," which is specially-designed paper with information encoded upon it for sending notes (see column 22, lines 10-15). The user writes this message using the above-described pointer, which also acts as a pen (see column 17, lines 13-21). Next, the user chooses a person to which to send the message by selecting the person in an "address book" document, itself encoded paper (see column 22, lines 15-18). Lastly, the message is sent by selecting a "Send" icon on the NotePaper (see column 22, lines 18-23). Dymetman further discloses that when a user positions the pointer on encoded paper, such as the above-described NotePaper, the encoded information in the vicinity of the tip of the pointer is read and decoded by special

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processing circuitry. This decoded information comprises a "page identifier," which concerns the identity of the encoded paper, and also a "location code," which concerns the location of the pointer within the paper. Using this location code and page identifier, the processing circuitry identifies a particular "action" to perform (see column 9, lines 10-28), such as that associated with the above-described Send icon. This processing circuitry, which may or may not be implemented entirely in the pointer, is considered a computer system (see column 15, line 15 – column 16, line 10). Moreover, the above-described Send icon is understood to be representative of a parameter for sending the message. It is interpreted that this processing circuitry identifies this parameter using a location code and page identifier when the user selects the Send icon. It is also interpreted that the recipient receives an image of the NotePaper (see column 22, lines 20-23), which thus includes the Send icon representative of this parameter. Therefore, Dymetman teaches: providing a participant with at least one conferencing form, namely the above-described NotePaper, which contains information relating to a remote conferencing session and including coded data, namely a page identifier and location code, which is indicative of an identity of the conferencing form and of at least one reference point of the conferencing form; receiving in a computer system indicating data from a sensing device, namely the pointer, which is operated by the conference participant, the indicating data regarding the identity of the conferencing form and a position of the sensing device relative to the conferencing form, the sensing device, when placed in an operative position relative to the conferencing form, sensing the indicating data using at least some of the coded data; identifying in the computer system and from the indicating data, at least one parameter, namely an "action" to perform, which relates to the conferencing

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session; and, providing at least one other conference participant with at least one conferencing form containing information representative of the at least one parameter.

Regarding claim 27, the above-described email method of Dymetman is implemented with one or more forms and a pointer comprising an image-reading device, an image-decoding device, and a network communication device (see column 15, lines 15-58). The combination of this pointer and the forms, implemented as described above, is considered a system like that of claim 27, which is for enabling remote conferencing between participants.

In reference to claims 2 and 28, Dymetman discloses that the parameter associated with a portion of encoded paper, such as the above-described Send icon, can relate to a zone of the encoded paper, and that this zone is identified by the above-described location identifier (see column 3, lines 61-63). Consequently, it is understood that the parameter relating to the conferencing session is associated with at least one zone of the conferencing form, and that the computer system identifies this parameter using the zone.

Regarding claims 3 and 29, Dymetman discloses that the pointer may operate in "Mouse Mode," whereby encoded data regarding pointer location is identified at a set frequency (see column 27, lines 24-44). In other words, data regarding pointer movement is received. Consequently, it is understood that with the above-described NotePaper being operated on with a pointer in Mouse Mode, the computer system receives data regarding movement of the pointer relative to the NotePaper, the pointer sensing its movement using at least some of the coded data, and also, the computer system identifies a parameter of the conferencing session from movement being at least partially within a zone.

As per claim 4, it is understood that for the reasons described above in the rejections for claims 1 and 3, Dymetman teaches a method comprising: providing a participant with at least one conferencing form, specifically NotePaper, which contains information relating to a remote conferencing session and including coded data indicative of at least one parameter of the remote conferencing session; receiving in a computer system, data from a pointer operated by the participant regarding the parameter and regarding movement of the pointer relative to the conferencing form, the pointer, when move relative to the conferencing form, sensing the data regarding the parameter using at least some of the coded data and generating the data regarding its own movement relative to the conferencing form; interpreting, in the computer system, the movement of the pointer as it relates to the parameter; and, providing at least one other conference participant with at least one conferencing form containing information representative of the parameter.

Regarding claim 30, the above-described email method of Dymetman is implemented with one or more forms and a pointer comprising an image-reading device, an image-decoding device, and a network communication device (see column 15, lines 15-58). The combination of this pointer and the forms, implemented as described above, is considered a system like that of claim 30, which is for enabling remote conferencing between participants.

Regarding claim 22, it is understood that a user of the above-described computerless email system of Dymetman may send an email message to a plurality of recipients or to a single recipient, as is known in the art. Consequently, it is interpreted that the conferencing forms may be distributed using a mixture of multicast and pointcast communications protocols.

As per claims 26 and 46, Dymetman discloses that the email is transmitted using a fax machine (see column 22, lines 12-23). As is known in the art, such a fax machine uses telephone lines to communicate. A fax machine is therefore considered telephone communication means. Consequently, Dymetman teaches providing the conference participants with telephone communication means for use during the remote conferencing session.

In reference to claim 31, Dymetman discloses that the parameter associated with a portion of encoded paper, such as the above-described Send icon, can relate to a zone of the encoded paper, and that this zone is identified by the above-described location identifier (see column 3, lines 61-63). Consequently, it is understood that the parameter relating to the conferencing session is associated with at least one zone of the conferencing form, and that the computer system identifies this parameter using the zone.

Regarding claim 32, the system disclosed by Dymetman, as described above in the rejection for claim 30, includes a pointer, i.e. sensing device.

In regard to claims 5 and 6, the NotePaper of Dymetman includes a Send icon, which as described above, represents a parameter for sending a message to a remote conference participant. This parameter is considered an "action parameter" as expressed in claim 5, since an operation for sending the message occurs with respect to this parameter. Moreover, this parameter is selected from the group comprising: sending an invitation to a conference session; starting a conference session; ending a conference session; viewing the history of a conference session; sending a message to a participant during a conference session; viewing messages sent during a conference session; ordering the printing of a palette of available line styles and colors; ordering the printing of a whiteboard page; updating a whiteboard page; and ordering the



reprinting of a new whiteboard page. Specifically, the parameter is associated with sending a message to a participant during a conference session.

Concerning claims 7 and 8, the address book document disclosed by Dymetman is encoded paper upon which a user may select, with a pointer, a person to which to send a message, as is described above in the rejection for claim 1. As this address book is directly associated with sending the message, the address book is likewise considered a conference form. Also, the person to whom to send the message is considered an option parameter, since the operation of sending the message is associated with this parameter. Moreover, Dymetman discloses that the above-described computer system identifies if the user has entered a hand-drawn mark (see column 17, lines 13-35). Dymetman thus teaches an option parameter, and also, identifying in the computer system that the participant has entered a hand-drawn mark by means of a pointer and effecting, in the computer system, an operation associated with the option parameter. Additionally, Dymetman teaches that this option parameter is associated with at least one of: an access level; a message recipient; a line style; and a line color. Specifically, the option parameter is associated with a message recipient.

With respect to claims 9-11, Dymetman discloses that a user's hand-written message may be converted to ascii text, *if desired* (see column 31, lines 23-25). Consequently, it is interpreted that a parameter may be associated with the above-described NotePaper such that when chosen, the message text is converted to ascii text, i.e. computer text. Such a parameter is considered a text parameter, like that of the claimed invention, whereby the computer system identifies that the participant has entered hand-written text by means of a pointer and effects, in the computer system, an operation associated with the text parameter. Specifically, the handwritten text is

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converted to computer text in the computer system. Moreover, such a parameter is associated with at least one of: a session description; a conference start data; a start time; an end time; a participant identification; a conference session purpose; a message subject description; and a message text. Specifically, the parameter is associated with message text.

Regarding claims 15 and 16, it is understood that a user may make drawings on the above-described NotePaper. Dymetman discloses that a user's drawings may be subject to various operations, such as smoothing and shape-recognition (see column 31, lines 7-17). Consequently, it is interpreted that one or more parameters may be associated with the above-described NotePaper such that when chosen, any shapes drawn are smoothed or identified as a circle, square, etc. Such parameters are considered graphical parameters like that of the present application, whereby the computer system identifies that the participant has entered hand-drawn graphical information by means of the sensing device and effects, in the computer system, an operation associated with the graphical parameter. Furthermore, such parameters are understood to be associated with a markup to a whiteboard page, wherein this case, the NotePaper is considered a whiteboard page.

As per claims 33-36 and 38, the conferencing forms disclosed by Dymetman are associated with at least one parameter selected from the group comprising an action parameter of the conference session, an option parameter of the conference session, a text parameter of the conference session, and authorization parameter of the conference session, and a graphical parameter of the conference session. In particular, the conferencing forms are associated with an action parameter, an option parameter, a text parameter, and a graphical parameter, as is shown above in the rejection for claims 5, 7, 9, and 15. More specifically, the action parameter

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disclosed by Dymetman is selected from the group comprising: sending an invitation to a conference session; starting a conference session; ending a conference session; viewing the history of a conference session; sending a message to a participant during a conference session; viewing messages sent during a conference session; ordering the printing of a palette of available line styles and colors; ordering the printing of a whiteboard page; updating a whiteboard page; and ordering the reprinting of a new whiteboard page. Specifically, as shown above in the rejection for claim 6, the action parameter is associated with sending a message to a participant during a conference session. The option parameter disclosed by Dymetman is associated with at least one of: an access level; a message recipient; a line style; and a line color. Specifically, the option parameter is associated with a message recipient, as is shown above in the rejection for claim 8. The text parameter disclosed by Dymetman is associated with at least one of: a session description; a conference start date; a start time; an end time; a participant identification; a conference session purpose; a message subject description; and a message text. Specifically, the text parameter is associated with message text, as is shown above in the rejection for claim 11. Lastly, the graphical parameter is associated with a markup to a whiteboard page, as is shown above in the rejection for claim 16.

As for claim 17, the NotePaper described above contains information relating to at least one of: booking a conference session; canceling a conference session; controlling a conference session; selecting invitees to a conference session; inviting participants to a conference session; composing messages in a conference session; sending messages in a conference session; viewing messages in a conference session; printing a palette of available line styles and colors in a conference session; selecting a line style and color in a conference session; viewing the history

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of a conference session; printing whiteboard pages; updating whiteboard pages; reprinting whiteboard pages; pasting content to a whiteboard page; and ending a conferencing session. For example, the NotePaper contains information relating to sending messages in a conferencing session, as is described above in the rejection for claim 1.

As per claims 18-20 and 41-43, it is interpreted that the NotePaper and other conference forms disclosed by Dymetman may be printed on demand by selecting a "Print" icon (see column 22, line 28). Consequently, it is understood that the above-described system comprises a printer. It is further interpreted that the conferencing form is printed on a surface of a surface-defining means and, at the same time that the conferencing form is printed, the coded data is also printed, whereby the coded data is printed to be substantially invisible in the visible spectrum (see column 11, lines 5-27; and lines 47-51).

In regard to claims 23 and 40, Dymetman discloses that the above-described pointer may contain an identification means, specifically a "pointer identifier," which imparts a unique identity to the pointer and identifies it as being associated with a user, whereby it is interpreted that the identity of this participant may be monitored (see column 17, lines 39-51).

Referring to claim 24, Dymetman does not disclose that a separate display device is used in the above-described email method. Consequently, it is understood that the conferencing forms of Dymetman provide all required information relating to the remote conferencing session, thus eliminating the need for a separate display device.

With respect to claim 39, Dymetman discloses that the above-described pointer may function as a pen (see column 17, lines 13-21). It is consequently interpreted that such a pointer includes a "marking nib" like that recited in claim 39.

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*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-15 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent of Dymetman, which is described above, and also over U.S. Patent No. 5,859,967, which is attributed to Kaufeld et al. (and hereafter referred to as Kaufeld). As described above, the computerless email method of Dymetman teaches a method and system like that of claims 1, 4, and 33. Dymetman further teaches that the above-described pointer may be used to write a signature, whereby the information captured by the pointer may be used in authorization applications (see column 31, lines 7-17). However, Dymetman does not explicitly disclose the use of such authorization applications in conjunction with the above-described computerless email method. In other words, Dymetman does not explicitly suggest that the conferencing forms specify an authorization parameter of the conferencing session, whereby as expressed in claim 12, a computer system identifies that the participant has entered a handwritten signature by means of the pointer and effects, in the computer system, an operation associated with the authorization parameter. Consequently, Dymetman does not disclose that the computerless email method includes verifying that this signature is that of the participant, as is recited in claim

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13, or that the authorization parameter is associated with updating a whiteboard page, as is expressed in claims 14 and 37.

Like Dymetman, Kaufeld presents a method and system for sending an email message to a recipient, whereby the recipient receives the email message via fax machine (see column 1, lines 12-17). Regarding the claimed invention, Kaufeld discloses that when the email message is sent to the recipient, the message is checked to determine if it is from an authorized user (see column 1, line 50 – column 2, line 43).

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Dymetman and Kaufeld before him at the time the invention was made, to modify the method taught by Dymetman to include the teachings of Kaufeld such that any sent email messages are checked for proper authorization. In other words, it would have been obvious to modify the conferencing forms taught by Dymetman such that they require signature authorization when sending a message. Such conferencing forms thus specify an authorization parameter of the conferencing session, whereby a computer system identifies that the participant has entered a handwritten signature by means of the pointer and effects, in the computer system, an operation associated with the authorization parameter, specifically sending the message to the recipient if the signature is verified as that of the participant. Lastly, it is understood that this authorization parameter is associated with updating a whiteboard page, i.e. sending the message. It would have been advantageous to one of ordinary skill to utilize such a combination because authorization of sent email messages increases security, as is taught by Kaufeld.

Claims 21 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent of Dymetman, which is described above, and also over U.S. Patent No. 6,330,589, which is attributed to Kennedy. As shown above, Dymetman discloses a method and system like that of claims 1, 4, and 27, whereby a user uses conferencing forms, specifically NotePaper and an address book, to generate and send email messages to a particular recipient. Dymetman, however, does not explicitly teach retaining a retrievable record of each conferencing form generated, the conferencing form being retrievable using its identity as contained in its coded data, as is expressed in claims 21 and 44.

Like Dymetman, Kennedy discusses using email as a medium for a conversation (see column 1, lines 7-10). More specifically, Kennedy discusses organizing email messages such that all messages relating to a particular conversation may be determined (see column 1, lines 48-67). Regarding the claimed invention, Kennedy discloses maintaining a database of each email message generated, which is interpreted to be used to retrieve and display prior messages (see column 2, line 33 – column 3, line 2). It is understood that each message is retrieved using a “message identifier,” which like the page identifier taught by Dymetman, uniquely identifies each message (see column 3, lines 30-44).

It would have been obvious to one of ordinary skill in the art, having the teachings of Dymetman and Kennedy before him at the time the invention was made, to modify the method taught by Dymetman to include the teachings of Kennedy such that a database for keeping a retrievable record of each conferencing form is generated, each conferencing form being retrievable using its page identifier included in its coded data. It would have been advantageous

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to one of ordinary skill to utilize such a combination because the ability to retrieve and view all email messages in a conversation thread is useful, as is demonstrated by Kennedy.

Claims 25 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent of Dymetman, which is described above, and also over U.S. Patent No. 5,592,280, which is attributed to Ishizuka et al. (and hereafter referred to as "Ishizuka"). As shown above, Dymetman discloses a method and system like that of claims 1, 4, and 41, whereby a user uses conferencing forms, specifically NotePaper and an address book, to generate and send email messages to a particular recipient. As also shown above, a printer or fax machine is used to print these forms. Dymetman, however, does not explicitly disclose that this printer or fax machine includes a binding means for binding the pages, as is expressed in claims 25 and 45.

Along the lines of Dymetman, Ishizuka presents a printer and fax machine, whereby regarding the claimed invention, the printer and fax machine are provided with a stapler to bind any printed pages (see column 1, lines 5-32).

It would have been therefore obvious to one of ordinary skill in the art, having the teachings of Dymetman and Ishizuka before him at the time the invention was made, to modify the method taught by Dymetman to include the teachings of Ishizuka such that the printer includes a binding means, specifically a stapler, for binding the printed forms. It would have been advantageous to one of ordinary skill to utilize such a combination because, as is taught by Ishizuka, binding printed forms is convenient for distributing copied sheets (see column 1, lines 12-14).



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*Conclusion*

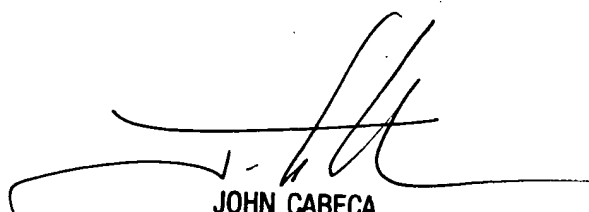
The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. The applicant is required under 37 C.F.R. §1.111(C) to consider these references fully when responding to this action. The Fujioka U.S. Patent cited therein discloses an apparatus to communicate handwritten messages and drawings during a conference session. The Dailey et al. U.S. Patent cited therein presents a method for conducting a meeting over a network wherein various email-based forms are used to setup the meeting.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blaine Basom whose telephone number is (703) 305-7694. The examiner can normally be reached on Monday through Friday, from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7238 for regular communications and (703) 746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

btb  
June 30, 2003



JOHN CABECA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100